



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,053	06/21/2000	Rodric C Fan	M-9199US	6523

32605 7590 07/27/2004

MACPHERSON KWOK CHEN & HEID LLP
1762 TECHNOLOGY DRIVE, SUITE 226
SAN JOSE, CA 95110

EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
----------	--------------

3662

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,053

Applicant(s)

FAN ET AL.

Examiner

Gregory C. Issing

Art Unit

3662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 136-179 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 136-145 is/are allowed.
- 6) ☒ Claim(s) 146-179 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3662

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 146-148, 152-157, 161-166, 170-174, 178 and 179 are rejected under 35 U.S.C. 102(e) as being anticipated by Fraccaroli.

Fraccaroli discloses a method and system for providing location-sensitive services in conjunction with wireless communications network ("Field of the Invention"). The system includes a plurality of mobile radio handsets 102, a server 106 and a matching engine 107. The mobile devices provide positional information to the server via network-based positioning, mobile-based positioning or hybrid positioning. Each mobile device also includes a matching profile to be associated with each User ID. The matching profile (the characteristics of the service subscribers, such as, of people whose proximity he wants to be made aware of and put in contact with if close enough) and requests for matches (interests and characteristics of people whose proximity will trigger the request for communication) are created and stored for each user. (col. 8) A user's interaction with their respective profile and related information is supported by their handset. The matching parameters 204 allows a user to specify the constraints for stating when matching should be attempted and typically include specification of the location area size and time (col. 9). The matching process is carried out automatically and in real-time without there ever being any action necessarily required by the user.

Thus, it is seen that Fraccaroli discloses the claimed method for operating first and second mobile devices wherein each mobile user (meeting the scope of the claimed first and second mobile devices) performs a transmission to a server including a profile (which meets the scope of the

Art Unit: 3662

claimed performing a network transmission to specify one or more conditions for a location relevant service to be performed by the server when the condition is met) and each mobile user also provides position to the server via a network-based, mobile-based or hybrid base method (meeting the scope of performing a network transmission of the location of the first mobile device), and wherein the server upon matching the profiles of users including location, time, characteristics, etc, pushes the information to the mobile device(s) (meeting the scope of the claimed server determining whether conditions are met and pushing the information to the second mobile device). Since any mobile handset is capable of being transported by a vehicle, and Fraccaroli teach traveling to other cities, use in a vehicle is anticipated.

Applicants argue that the prior art fails to suggest use by a user to set up a service on server (HQ computer of Bunn) to receive pushed information on a condition relevant to the location of a mobile device used by another user as defined by paragraph (1) of claim 146 and claim 155. Applicants allege patentability of claims 164 and 172 since the first mobile device is contained in a vehicle and the second is not contained in the same vehicle and also that a device not in a vehicle can be used to set up a service on a server to receive pushed information on a condition relevant to the location of the device in the vehicle. These arguments are not convincing in light of the newly cited reference to Fraccaroli that clearly shows setting up a respective service using a matching profile on a server, sending positional data to the server for respective users, and determining at the server a matching condition on the basis of the relative positions, i.e. within predetermined proximity, and profile characteristics, automatically sends a message to the appropriate user. Matching parameters allow the user to specify constraints to the profile parameters. The communication link directly between the mobile users meets the scope of the claimed first communication link whereas the communication link between the respective mobile users and the transmission network meets the scope of the second communication link.

Art Unit: 3662

3. Claims 146-150, 152-159, 161-168, 170-176, 178 and 179 are rejected under 35 U.S.C. 102(e) as being anticipated by Buckham et al.

Buckham et al disclose a server node (170), a wireless network (160), a mobile client (140) and mobile resources (110, 120). The mobile client, which reads on the claimed second mobile device, and mobile resources, which read on the claimed first mobile device, communicate via a conventional wireless network (160). Each of the mobile resources, which may comprise a PDA, wireless telephone or laptop computer, provides its location (location relevant information) to the server. The mobile client, exemplified by a dispatcher or fleet manager or a traveler locating local services, sends a message to the server requesting mapping and marker information. The marker information, which may take the form of mobile resource device (claimed first mobile device) locations, may be updated on demand or in response to other events such as crossing a defined boundary. Alternatively, the need for additional mapping information may be triggered by a variety of events including a selected mobile resource traveling outside of the boundaries of the previously transmitted mapping information. Moreover, the mobile client may set various monitoring parameters including polling frequency or triggering events (col. 11). Based on the parameters, the server will receive the mobile resource positions for the identified resources and transmit mapping information with respect thereto.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 151, 160, 169, and 177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckham et al in view of Bunn.

Art Unit: 3662

Buckham et al teach the subject matter substantially as claimed including event triggering of information but do not describe the event triggering in response to vehicle maintenance conditions.

Bunn et al teach the conventionality of each of traffic conditions, operating conditions as well as maintenance conditions. As such it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Buckham et al by including maintenance conditions as a triggering event in view of the conventionality of such as shown by Bunn et al.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Tanaka discloses a plurality of mobile users (2), such as a wireless mobile phone, PDA or laptop, that establish profiles in a server (5) database (6). The mobile users additionally have means for determining position (1), such as a GPS receiver, as well as communications means via a mobile communications infrastructure (3). Each user creates and stores the profile (7) in the server database. Subsequently, a user submits a search request to the server with search criterion and has own position embedded therein.

8. The prior art do not show the features of claims 136-145 wherein the passing of information between the mobile devices and the server includes the passing of information from one of the mobile devices through the other one of the mobile devices.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

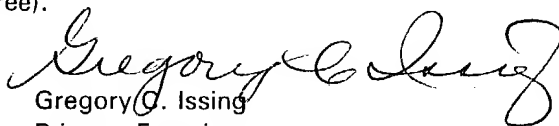
Art Unit: 3662

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is 703-306-4156. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on 703-306-4171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci